

REMARKS

Claims 1-15 have been presented for examination.

The rejection of claims 1 and 2 under 35 U.S.C. § 112 has been withdrawn.

However, the Examiner maintains his rejection of claim 3 under 35 U.S.C. § 112, second paragraph.

The Examiner contends that claim 3 does not recite any change in the condition data. To address the Examiner's position, claim 3 has been amended to recite the step of transmitting modified process condition data.

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Angle in view of the U.S. or German patent to Gleis. It is noted that the U.S. and German patents to Gleis disclose the same invention.

This rejection is respectively traversed for the following reasons. In the application of a rejection under 35 U.S.C. §103, it is incumbent upon the Examiner to factually support a conclusion of obviousness. As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 U.S.P.Q. 459, 465 (1966), obviousness under 35 U.S.C. §103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art.

Claim 1 recites a product control method of controlling processes of producing a product by wireless communication between a communication device associated with said product and a computer controlling said process of producing said product, comprising the steps of:

- preparing in said computer a control table storing control data controlling said product corresponding to an identification number for identifying said communication device;

- transmitting said identification number and information requesting the control data, from said communication device to said computer by wireless communication;

- transmitting, from said computer to said communication device identified by said identification number, control data stored in said control table corresponding to said received identification number in response to reception of said identification number and said information requesting the control data from said communication device;

- receiving in said communication device said control data from said computer;
and

- outputting control data relating to said product in a form recognizable to a person based on said received control data.

The Examiner takes the position that Angle differs from the claimed invention only in that the reference does not disclose associating the communication device to a product. Gleis is relied upon for disclosing this feature.

As demonstrated below, the Examiner has failed to properly ascertain the differences between the prior art and the claims in issue.

In the previous Amendment, Applicant submitted that Angle does not disclose the claimed steps relating to producing a product. In particular, Angle does not suggest a control table storing control data controlling the product corresponding to an identification number for identifying the communication device. The Examiner relies upon col. 10, lines 37-48 of Angle for disclosing this step. However, this portion of the

reference discloses a table that stores network addresses of various devices of the network, and nicknames associated with the corresponding network addresses. For example, the table stores the first name of an operator of a network terminal, together with the network address of the terminal, and the nickname of each recipient.

In response, the Examiner admits that this teaching of Angle is “in the context of sending voice data.” However, the Examiner takes the position that “in the context of a manufacturing facility, it would be obvious to one of ordinary skill in the art that this data could comprise “control data controlling said product.”

The Examiner’s position is respectfully traversed. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). This showing by the Examiner is an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

However, the Examiner provides no reason why one having ordinary skill in the art would have been led to modify the Angle teaching of a table that stores network addresses of various devices of the network, and nicknames associated with the

corresponding network addresses, in order to arrive at the claimed step of preparing in the computer a control table storing control data controlling the product being produced corresponding to an identification number for identifying the communication device associated with the product.

It is respectfully submitted that Angle does not teach or suggest any process for producing a product, and does not teach or suggest associating the communication device with the product being produced. Accordingly, the reference provides no suggestion to prepare a control table storing control data controlling the product being produced, as claim 1 requires.

If the Examiner relied upon common knowledge of the art or “well known” prior art without expressly indicating such reliance, the Examiner is respectfully requested to cite a reference in support of his position (see MPEP 2144.03).

Hence, the Examiner has failed to provide the requisite reasons for modifying the Angle reference and thus to establish a *prima facie* case of obviousness.

It is noted that Gleis also does not suggest the claimed step of preparing in said computer a control table storing control data controlling said product corresponding to an identification number for identifying said communication device.

Hence, a combination of Angle with Gleis is not sufficient to suggest the claimed step.

Moreover, inasmuch as the references do not disclose storing product control data corresponding to an identification number of the communication device, they cannot suggest the claimed protocol involving the transmission and reception of the control data and the identification number.

Accordingly, a combination of Angle with Gleis would not suggest the steps of:

- transmitting said identification number and information requesting the control data, from said communication device to said computer by wireless communication;
 - transmitting, from said computer to said communication device identified by said identification number, control data stored in said control table corresponding to said received identification number in response to reception of said identification number and said information requesting the control data from said communication device;
 - receiving in said communication device said control data from said computer;
- and
- outputting control data relating to said product in a form recognizable to a person based on said received control data, as claim 1 recites.

Independent claim 11 recites a product control method of controlling a process of producing a product by a communication device associated with said product and a computer controlling said process of producing said product by wireless communication, comprising the steps of:

- preparing in said computer registration data of said product corresponding to an identification number for identifying said communication device;
- selecting said product stored in said registration data;
- transmitting calling data from said computer to said communication device designated by said identification number corresponding to said product selected in said step of selecting said product; and

- performing a prescribed operation in said communication device identified by said calling data based on said received calling data in response to reception of said calling data from said computer.

In the previous Amendment, Applicant submitted that Angle does not describe preparing registration data of the product corresponding to an identification number for identifying the communication device.

In response, the Examiner asserts that he finds this limitation to be obvious in view of Gleis. The Examiner concludes that "if Angle was modified to associate the communication device with the product, as argued in the previous rejection, then the step of "preparing registration data" would inherently follow."

The Examiner is respectfully reminded that inherency requires certainty, not speculation. *In re Rijckaert*, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probability or possibilities. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner provided no factual basis upon which to conclude that the step of preparing in the computer registration data of the product corresponding to an identification number for identifying the communication device is necessarily present in

Angle or Gleis. Moreover, one skilled in the art would understand that this step is not carried out in the systems described in these references. Accordingly, the Examiner's conclusion of inherency is unwarranted.

Also, Applicant submitted that the reference does not teach selecting the product, and transmitting calling data designated by the identification number corresponding to the selected product.

In response, the Examiner asserts that this feature "would obviously follow" if Angle was modified to associate the communication device with the product.

However, the Examiner provides no evidence to support his position of obviousness. As discussed above, the Examiner must provide a reason why one having ordinary skill in the art would have been led to modify the Angle teaching to arrive at the step of selecting the product, and transmitting calling data designated by the identification number corresponding to the selected product. One skilled in the art would understand that no such reasons exist, because Angle does not suggest any process of producing a product.

Applicant respectfully submits that the Examiner has improperly applied hindsight as a basis for a holding of obviousness. The test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985).

As demonstrated above, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to claims 1 and 11. Dependent claims 2-

10 and 12-15 are defined over the prior art at least for the reasons presented above in connection with the respective independent claims 1 and 11.

In view of the foregoing, and in summary, claims 1-15 are considered to be in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested.

Entry of the amendment of claim 3 under 37 CFR § 1.116 is respectfully requested because the amendment complies with requirements of form expressly set forth in the previous Office Action.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Alexander V. Yampolsky
Registration No. 36,324

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SAB:AVY:men
Facsimile: (202) 756-8087
Date: June 1, 2004